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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,660	11/24/2003	Takuya Matsumoto	HOK-9022/CON	1610

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/718,660	MATSUMOTO ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11-24-03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims tabulated below of U.S. Patent No. 6,763,334.

Instant Claim	Claim in US Pat. 6,763,334
25	1
26	2
27	5
28	9
29-31	respectively 10-12
32-34	1
35	7&8
36-39	1

   Instant independent claim 36 is claim 1 in the '334 patent with the first half of its limitations deleted. It is obvious to delete limitations. Instant claims 25-31 are also derived from the

claims in the '334 patent in the table given above by deleting the first half of the limitations of parent claim 1. Independent claim 25 also differs from independent claim 35 by using the obvious phrase "a result number is the number of actions made in response to an action object for necessitating processing at said action process module" in place of the claim 35/claim 1 phrase "a result number is the number of the access to said process module". Claims 26-31 otherwise do not differ materially from the '334 pat. claims indicated in the table above. Claims 32-34 each add back one or two of the deleted claim 1 limitations. Instant claim 35 is claim 8 in the '334 pat. with the file definitions copied from claim 7. Claim 37 is the method equivalent of system claims 25/1. Claims 38 and 39 are taught inherently because the common mouse button reads on the claimed buttons for display and download.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 25-39 are rejected under 35 U.S.C. 103(a) as being obvious over Gerace (US005848396A) in view of Domine et al. (US005949419A).

5. Gerace teaches (independent claims 25, 36 and 37) a system and method for arranging the delivery of ads over a network (col. 3 line 30), the system comprising: a response measurement module (*User Objects **37d**, **37e*** and ***37f***, col. 6 lines 41 to col. 7 line 22) counting the number of specific responses made at *web server **27*** running program ***31*** (col. 3 lines 57-62), which reads on at a web site of an advertiser through an ad space (*banners*, col. 8 line 13-15 and Appendix I, esp. col. 23 lines 18-20) of a network medium; an administration module making a statistical report (col. 3 lines 11-19) for analysis of the counted responses and delivering said statistical report through said agent's server to the advertiser (col. 5 lines 34-37), wherein said web site includes an entrance page (*Home Page*, col. 7 lines 39-45) and an action page (*Financial Pages*, etc.) linked from said entrance page/*Home Page* and containing said ad pages/*banners*, which reads on the entrance page/*Home Page* being linked to the ad pages/*banners*, and where a user of said

network may proceed to make at least one specific action of defined responses as a consequence of the ad on said network (col. 5 lines 24-34), and an action process module which responds to said specific action for processing the same, wherein said administration module produces said statistical report listing the page location of each ad (col. 19 lines 7-9) and the number of viewers of each ad (col. 5 lines 27-29), which reads on an action access number (number of accesses to said action page), and a result number (the number of actions made in response to an action object, col. 5 lines 25-34), wherein said statistical report includes a graphic comparison of user density versus click through or purchase density (col. 13 lines 27-29), which reads on a completer rate.

6. Gerace does not teach reporting a page access number (the number of accesses to the entrance page) and a proceeder number (the ratio of action access number to page access number). However, Gerace does teach compiling page access number data (col. 6 lines 46-48), which reads on the website's *traffic data*. Because Domine et al. teaches (col. 3 line 62 to vol. 4 line 12) that traffic is important to the success of a web site, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add reporting of page access number/traffic data to the teachings of Gerace. Furthermore, because proceeder number is a measure of the rate at which web site traffic is converted to ad viewers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to also add reporting of proceeder number to the teachings of Gerace.

7. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

8. The instant application contains no such clear definitions for any terms, including "ad space", "web site of an advertiser", "log file" and "button". The examiner is accordingly

obligated to give these terms their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111).

9. Gerace also teaches at the citations given above claims 26, 27, 34 and 35 (inherently). Gerace also teaches claims 29 and 30 (col. 19 line 66 to col. 20 line 2) and claims 32 and 33 (where the *Home Page* reads on the invitation page, col. 17 lines 53-57 and col. 11 line 57 to col. 12 line 41). Gerace also teaches claims 38 and 39 inherently because the common mouse button reads on the claimed buttons for display and download.

10. Neither reference teaches (claims 28 and 31) listing performance statistics on a daily basis and ranking referred URLs. Gerace does teach reporting performance data "by time" (col. 19 lines 62-65) and compiling referred URL data (col. 6 lines 48-50). Because the data are available and would be of value to advertiser customer, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Gerace that performance statistics are listed on a daily basis and referred URLs are ranked.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal*

fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

14. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

16. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration. Applicant may have after final arguments considered and amendments entered by filing an RCE.

17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

7 January 2006